

REMARKS/ARGUMENTS

This reply is fully responsive to the Office Action dated 12 MAY 2008, and is filed within FOUR - (4) months following the mailing date of the Office Action.

5

Objection/Rejection Summary:

This application has been carefully reviewed in light of the Office Action of May 12, 2008, wherein:

- A. Claim 34 was rejected under the non-statutory obviousness-type double patenting as
10 being unpatentable over Claim 6 of U.S. Patent No. 6,735,448, issued to Krishnamurthy et al. (hereinafter referred to as the “Krishnamurthy patent”); and
- B. Claims 1-39 were rejected under 35 U.S.C. § 102(a) as being anticipated by ElBatt et al. (“Power Management for Throughput Enhancement in Wireless Ad-hoc Networks,” IEEE International Conference on Communications, pp 1506-1513, Vol. 3, June 18-22,
15 2000, hereinafter referred to as the “ElBatt article”).

Claim Rejections – Double Patenting

- A. In the current Office Action, the Examiner rejected Claim 34 under the non-statutory obviousness-type double patenting as being unpatentable over Claim 6 of U.S. Patent No.
20 6,735,448, issued to Krishnamurthy et al. (hereinafter referred to as the “Krishnamurthy patent”).

The Examiner stated that the non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the “right to exclude”
25 granted by a patent and to prevent possible harassment by multiple assignees. The Examiner further stated that “a non-statutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been
30 obvious over, the reference claim(s).” See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed Cir.

Reply to Office Action of May 12, 2008

1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5 The Examiner further stated that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken
10 within the scope of a joint research agreement.

Furthermore, the Examiner stated that effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15

In particular, the Examiner stated that although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 34 of the present application is a broader version of Claim 6 of the Krishnamurthy patent. The Examiner further stated that the removal of the additional limitations
20 disclosed in Claim 6 of the Krishnamurthy patent from Claim 34 of the present application made Claim 34 a broader version of Claim 6 of Krishnamurthy patent, and thus, Claim 34 is not patentably distinct from Claim 6 of the Krishnamurthy patent since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same
25 functions as before. *In re Karlson* (CCPA) 136 USPQ 184 (1963).

Regarding the Claim Rejections under Double Patenting

The cited prior art does not establish a non-statutory obviousness-type double
30 **patenting ground**

The courts have ruled that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

5

The Applicants respectfully submit that the present application and the cited Krishnamurthy patent, US Patent No. 6,735,448, are both commonly owned by HRL Laboratories, LLC, Malibu, CA (US). In addition, attached with this reply, please find a Terminal Disclaimer in compliance with 37 CFR 1.321(c).

10

Therefore, because the terminal part of any patent that issues on the present application is disclaimed (according to the terms of the attached Terminal Disclaimer), the Applicants respectfully request that the Examiner withdraw this Double Patenting rejection of Claim 34.

15

Claim Rejections - 35 USC § 102(a)

B. In the current Office Action, the Examiner rejected Claims 1-39 under 35 U.S.C. § 102 (a) as being clearly anticipated by the ElBatt article.

20

Regarding the rejections of independent Claims 1-39 over the ElBatt article

The cited prior art does not establish a prima facie case of anticipation

In order to establish a prima facie case of anticipation the Examiner must set forth an argument that provides (1) a single reference (2) that teaches or enables (3) each of the claimed elements (as arranged in the claim) (4) either expressly or inherently and (5) as interpreted by one of ordinary skill in the art. All of these factors must be present, or a case of anticipation is not met.

25

30

The Applicants assert that the Examiner has failed to establish a single reference that teaches or enables each of the elements of the claimed invention. Specifically the

Reply to Office Action of May 12, 2008

Applicants submit that the Examiner has failed to set forth a prima facie case of anticipation because Applicants firmly believe that that the present invention was conceived prior to the publication date of the ElBatt article, and as such, the ElBatt article should not be considered prior art with respect to the present invention.

5

The ElBatt article should not be considered prior art with respect to the present invention

The Applicants submit that the present invention is a continuation of, and thus claims the benefit of priority to, US Patent Application No. 09/708,271 and US Patent No.

10 6,735,448, filed in the United States on November 7, 2000, and title "Power Management for Throughput Enhancement in Wireless Ad-Hoc Networks."

The Applicants further submit that the ElBatt article is an academic publication that was published on the IEEE International Conference on Communications, on June, 2000.

15 Furthermore, the Applicants submit that the present invention was conceived prior to the publication date of the ElBatt article. As sworn to in the attached 37 CFR 1.131 declaration signed by the inventors, the present invention was invented at least as early as April 19, 1999 (more than a year before the publication date of the ElBatt article) when the first named inventor, Srikanth Krishnamurthy, first completed a conception of the invention, and when a finalized Invention Disclosure was signed by the inventors and
20 stamped by HRL Laboratories, LLC (as evidenced by the Invention Disclosure, included therewith as Appendix A).

Because the present invention is a continuation of US Patent No. 6,735,448 and thus claims the benefit of priority to the filing date of November 7, 2000, the Applicants further submit that the present invention was diligently pursued until at least the benefit
25 of priority filing date of November 7, 2000 and until the continuation filing date of April 1, 2004.

Because the present invention was invented at least as early as April 19, 1999, the present invention was conceived prior to the publication date of the ElBatt article

Reply to Office Action of May 12, 2008

(June 2000). Thus, the Applicants believe that with the attached §1.131 declaration, the ElBatt article can no longer be considered prior art with respect to the present invention.

Therefore, the Applicants respectfully request that the Examiner withdraw this rejection
5 under 35 U.S.C. § 102 (a) and provide for timely allowance of Claims 1-39.

Reply to Office Action of May 12, 2008

Closing Remarks:

The Applicants respectfully submit that, in light of the above remarks, the application and all pending claims are now in allowable condition. Therefore, reconsideration is respectfully requested. Accordingly, early allowance and issuance of this application is respectfully requested.

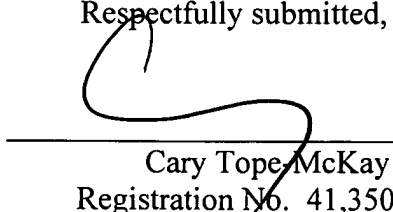
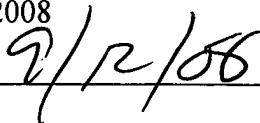
In the event that the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either the Applicants or Applicants' representative would be beneficial the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-2691. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 50-2691.

Respectfully submitted,

09/12/2008

Date


Cary Tope-McKay
Registration No. 41,350

Cary Tope-McKay
TOPE-MCKAY & ASSOCIATES
23852 Pacific Coast Highway #311
Malibu, CA 90265
Tel: 310-589-8158
Mobile: 310-383-7468
Fax: 310-943-2736
E-mail: cmckay@topemckay.com